

REMARKS

1. In the Office Action, the Examiner rejected all pending claims (Claims 175-197) under 35 U.S.C. 103(a) as being unpatentable over Perry (U.S. Pat. No. 5,241,466) in view of Krim (U.S. Appl'n Pub. No. 2002/0072925), and further in view of Mindrum (U.S. Pat. No. 6,340,978). For the reasons discussed below, the Applicant respectfully submits that a *prima facie* conclusion of obviousness has not been established based upon Perry, Krim, and Mindrum.

It is the Examiner's Burden to Prove a Prima Facie Case of Obviousness

2. "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP § 2142. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

Id.

Neither Perry, Krim, nor Mindrum, nor the Combination of the Three, Teach or Suggest All Claim Limitations of the Present Invention

3. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the

patentability of that claim against the prior art.’ In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” MPEP § 2143.03.

4. As explained below, there is no motivation or suggestion to combine Krim, Perry, and Mindrum. Nevertheless, their combination does not teach or suggest each and every limitation of the two independent claims, Claims 175 and 199, as required to support a *prima facie* conclusion of obviousness.

Mindrum Does Not Teach or Suggest Any Elements of the Claimed Invention

5. Turning first to the new reference Mindrum, the Examiner states that Mindrum discloses the following elements:

- a. “providing via said interface guidance information comprising at least one input form, said at least one input form comprising electives available to said participant regarding said future care, and reference information associated with said available electives”
- b. “analyzing said available electives in response to input by said input user to provide via said interface analysis information regarding said future care to allow informed choices of said electives to be made”
- c. “receiving from said input user via said interface at least one election of at least one of said electives”
- d. “storing in a computer-readable registry end-of-life information and said unique identification parameter in the form of an information set corresponding to said participant, said end-of-life information comprising

said received raw data and said at least one election”

- e. “if so, generating an information product derivative of said information set comprising said participant’s election corresponding to said incapacitated state, said information product being generated in a form that is enforceable in the jurisdiction from which said request was received”

6. The Examiner cites, without any explanation, two general passages from Mindrum, Col. 3, Lines 27-67 and Col. 4, Lines 13-67, in support of the rejection. Far from describing, teaching, or even suggesting the elements set forth above, these passages from Mindrum, as well as the reference as a whole, do not contain even a hint of the elements of the claimed invention. Each element is addressed in the following paragraphs.

7. As an initial matter, it is well settled that "applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. . . . [A] claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought." MPEP 2173.01. "A term used in the claims may be given a special meaning in the description." MPEP 608.01(o). In this instance, the terms “guidance information,” “elective,” “analysis information,” “incapacitated state,” “end of life information,” and “information product” are defined in the specification. Some of these terms have been explicitly set aside in a definitional section added by amendment (see Request for Continued Examiner, 10/6/2004); the remainder are clearly defined in the specification. “The specification should also be relied on for more than just explicit

lexicography or clear disavowal of claim scope to determine the meaning of a claim term when applicant acts as his or her own lexicographer; the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in context in the specification. MPEP 2111.01 (Part III) (citing *Phillips v. AWH Corp.*, ___F.3d___, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc); and *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996)). Although these terms are not even used anywhere in Mindrum, as explained below, the Examiner is not permitted to graft onto these terms meanings inconsistent with their use in this application.

8. **“providing via said interface guidance information comprising at least one input form, said at least one input form comprising electives available to said participant regarding said future care, and reference information associated with said available electives”**

- a. All Mindrum discloses or teaches is an interface to allow “simple storage” of information sent by the user, “permanent and non-degradable storage (and retrieval) of family memories.”
- b. Mindrum does not teach, suggest, or disclose in any way, shape or form *providing to the user* “guidance information” regarding future health care choices, as that term is used and described in the present information.
- c. Mindrum does not teach, suggest, or disclose in any way, shape or form *providing to the user* an “elective” or choice regarding future health care.
- d. Mindrum does not teach, suggest, or disclose in any way, shape or form *providing to the user* “reference information” regarding these future health care electives.

9. **“analyzing said available electives in response to input by said input user to provide via said interface analysis information regarding said future care to allow informed choices of said electives to be made”**

- a. The action performed by this step is “analyzing.” Mindrum does not do any analysis whatsoever. None. Mindrum merely archives or records whatever information the user decides to put into it. On this basis alone, the obviousness rejection is inadequate and should be removed.
- b. Mindrum does not teach, suggest, or even hint at the possibility of an “elective,” which is defined to be a choice or “elections of information products, types of information products, or characteristics of information products that the system can produce or forward for the participant in the event of an end-of-life condition.”
- c. Mindrum does not provide “analysis information” to the input user. As described in the specification, analysis information is “qualitative and quantitative information about specific medical conditions and corresponding treatments (including end-of-life condition responses) that are relevant to the participant.”
- d. Mindrum has nothing to do with making choices about the “future care,” i.e., future medical care, of the user. Neither Mindrum nor Krim nor Perry enables any choices to be made regarding future health care in the event of an incapacitated state.

10. **“receiving from said input user via said interface at least one election of at least one of said electives”**

- a. The action performed by this step is “receiving” an election. Mindrum does not teach, suggest, or even hint at providing the capability for the input user to make an election regarding future health care.
- b. Consequently, Mindrum does not disclose “receiving” any such election.

11. **“storing in a computer-readable registry end-of-life information and said unique identification parameter in the form of an information set corresponding to said participant, said end-of-life information comprising said received raw data and said at least one election”**

- a. Because Mindrum does not enable an election by the user regarding his future care in the event of an incapacitated state, and because Mindrum does not receive such an election, it does not store such an election.

12. **“if so, generating an information product derivative of said information set comprising said participant’s election corresponding to said incapacitated state, said information product being generated in a form that is enforceable in the jurisdiction from which said request was received”¹**

- a. Mindrum contains absolutely no suggestion of this capability of the present invention.
- b. Mindrum does not address anywhere in the cited passages generating an information product including an election regarding future medical care in the event of a specific incapacitating condition that is enforceable in the jurisdiction from which the request was received.

¹ The analogous element in Claim 199 is as follows: “upon receiving a request from an output user identifying the occurrence of an incapacitated state in said participant, generating an information product derivative of said information set comprising said participant’s election corresponding to said incapacitated state.” As stated above, Mindrum does not disclose the ability to generate *anything* that reflects an election regarding a future health care choice.

- c. The words “incapacitated,” “enforceable,” “election,” and “jurisdiction” are nowhere even found or suggested in Mindrum.
- d. Moreover, it must be emphasized that as used in this application, and in this claim, “dead” is not an incapacitated state. That is, the invention does not relate to health care decisions to be made *after* the person is dead; it is too late, then. The claim explicitly limits the election to “to the future care of a participant should said participant **prior to death** become incapacitated.”

13. In view of the above, the Examiner has failed to show how Mindrum teaches any element of the claimed invention, including those cited by the Examiner. The Examiner’s conclusory citation to broad passages of Mindrum are insufficient.

Perry and Krim Do Not Teach or Suggest the Remaining Elements of the Claimed Invention

14. Likewise Perry and Krim fail to disclose the elements cited by the Examiner. In addition to receiving documents or information from a user (such as in Perry), the system of the present invention provides reference information and analysis to the user regarding available choices of future care (“electives”) in the event of an incapacitating condition and then permits the user to make elections of such choices. Neither Perry nor Krim disclose, teach, or suggest such analytical guidance and decision-making capability. As shown above, Mindrum also fails to teach these elements.

The Examiner Has Not Identified Any Suggestion or Motivation to Combine Krim, Perry, or Mindrum

15. The first step of the inquiry is that there must be some suggestion or motivation to combine the references. “Obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP § 2143.01. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Id. (emphasis in original) (citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)).

16. The Examiner provides no basis in the Office Action for combining Perry, Krim, and Mindrum. Therefore, the Examiner has failed to establish a *prima facie* conclusion of obviousness.

17. Because independent claims 175 and 199 are nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03. Therefore, the obviousness rejection should be removed as to Claims 176-186, and 200-208.

Summary and Conclusion

18. A *prima facie* case of obviousness has not been established. Mindrum simply does not contain the subject matter for which it was cited by the Examiner. Moreover, no suggestion or motivation to combine Krim, Perry, and Mindrum was provided in the Office Action. Even if Krim, Perry, and Mindrum are combined as suggested by the Examiner, they do not teach each and every element of the claimed invention. Based on the foregoing, each of which provides an independent basis for withdrawal of the obviousness rejection, the Applicant respectfully submits that the

obviousness rejections of all pending claims based on Krim, Perry, and Mindrum are improper and requests the rejections be withdrawn.

The applicant submits that the present claims are allowable over the prior art of record. It is believed the application is therefore in condition for allowance, and such action is respectfully requested. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned at (205) 521-8766 so that such issues may be resolved as expeditiously as possible.

10-3-06

Date

Respectfully Submitted,



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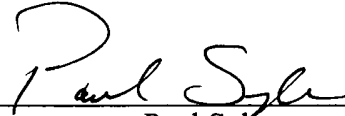
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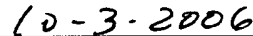
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on October 3, 2006.

A handwritten signature in cursive script, appearing to read "Paul Sykes", is written over a horizontal line.

Paul Sykes
Attorney for Applicant

A handwritten date "10-3-2006" is written over a horizontal line.

Date of Signature